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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,266

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Michael A. Fetcenko

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1742

MAIL DATE

DELIVERY MODE

05/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,266

Applicant(s)

FETCENKO ET AL.

Examiner

George P. Wyszomierski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 29-34 and 36-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 29-34, and 36-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The Request for Continued Examination (RCE), fee, and Amendment filed February 15, 2007 are considered proper and have been entered into the file. The pending claims are claims 1, 29-34, and 36-56. It is noted that no claim numbered "35" has ever been presented in this application; in any future amendments, claim 35 should be identified as a "canceled" claim.

2. Applicant has amended the specification to designate that the present application is a divisional of an earlier filed nonprovisional application. Because this designation was requested after the time periods provided by 37 CFR 1.78(a)(2)(ii), then a petition must also be filed as set forth in 37 CFR 1.78(a)(3). Particularly, in the present case, items (ii) and (iii) of that section (surcharge, statement that entire delay was unintentional) should accompany the petition.

3. The following is a quotation of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 29-34 and 36-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, nothing in the specification as originally filed disclosed, either explicitly or implicitly, the presently

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claimed limitation in claim 1 that "said first reactant does not comprise a hydroxide group". It should be noted that the lack of a disclosure of a particular feature in the specification will not generally support a negative limitation in a claim directed to the absence of that feature. Thus claim 1 and dependent claims 29-34 and 36-47 are rejected under this statute.

Applicant's remarks on page 7 of the Amendment filed February 15, 2007 have been fully considered. However, nothing in the remarks themselves or in the page of the specification referred to in the remarks discloses the exclusion of a hydroxide group in any clear manner, nor would this feature appear to be inherent in practice of what is disclosed.

5. Claims 50-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are dependent upon canceled claims. For purposes of examination, claims 50, 53, 54 and 55 are being treated as dependent upon claim 48, claim 51 as dependent upon claim 50, claim 52 as dependent upon claim 51, and claim 56 as dependent upon claim 55.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Bogauchi et al. (U.S. Patent 5,489,314), Ovshinsky et al. (U.S. Patent 5,523,182), Baba et al. (U.S. Patent 5,702,762), or Sakamoto et al. (U.S. Patent 6,153,334), or under 35 U.S.C. 102(e) as being anticipated by Tanigawa et al. (U.S. Patent 6,471,890).

The examples of Bogauchi, Ovshinsky, Baba, Sakamoto, and Tanigawa disclose specific processes that are completely in accord with those as defined in the instant claims. It is noted that the prior art references do not recite the word "preoxidized". This is not seen as distinguishing the claimed invention from the prior art because, given that the prior art discloses processes which completely match the steps as recited in the instant claims, any amount of oxidizing that may occur in such processes is held to be the same in either the prior art or the claimed invention. Whether one chooses to call the final product of such a process "preoxidized" or "partly oxidized" or "substantially oxidized" or any other similar terms is seen as a matter of semantics, rather than defining any actual difference in the process itself or in the materials formed by the process.

8. Claims 1, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakamoto et al.

Sakamoto column 10, lines 10-39 discloses a process completely in accord with that defined in the instant claims. None of the initial nickel-containing materials in this process of Sakamoto comprise hydroxide groups. The remarks regarding "preoxidized" material in the preceding paragraph apply equally as well in this instance.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Bogauchi et al., Ovshinsky et al., Baba et al., Sakamoto et al., or Tanigawa et al.

The prior art references do not specify forming a complex between the second reactant and the nickel of the first reactant, and do not specify the oxidation state of the nickel. However,

a) The specific substances formed in the prior art reactions would depend upon the actual reactants used and the processing conditions present. Because these factors may be the same in the prior art and the present invention, one of skill in the art would expect the same results, in the form of complexes or otherwise from those reactions, in both the prior art and the invention.

b) The only known oxidation states of nickel are +2 and +3 as presently claimed; it is a therefore reasonable assumption that the prior art nickel materials would comprise nickel in the claimed oxidation state(s).

Thus, a prima facie case of obviousness is established between the disclosures of Bogauchi et al., Ovshinsky et al., Baba et al., Sakamoto et al., or Tanigawa et al. and the presently claimed invention.

11. Claims 30-33, 36, 40, 41, 43, 44, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al.

Sakamoto does not specify the precise limitations as defined in the instant claims.

However,

a) With regard to claims 30-32, 46 and 47, the degree of oxidation is clearly dependent upon such factors as the composition of the initial material, the precise oxidation agent used and in what amount, and the temperature employed in the prior art processes. All of these parameters can be varied in the Sakamoto process, as evidenced by the numerous examples disclosed therein. Thus, the examiner's position is that one of ordinary skill in the art would have easily been able to vary the reaction conditions in Sakamoto to achieve a desired degree of oxidation.

b) With regard to claim 33, the remarks made supra with respect to the oxidation state of nickel apply equally as well in this instance.

c) With respect to claim 36, example 7 of Sakamoto employs a nitrate as presently claimed in the prior art process.

d) With respect to claims 40 and 41, example 8 of Sakamoto discusses the preparation of powders containing cobalt. Thus, to produce materials in accord with the instant claims would have been well within the level of one of ordinary skill in the art.

e) With respect to claim 43, the prior art process includes the production of spherical powders as presently claimed.

f) With respect to claim 44, the Abstract of Sakamoto discloses a tap density as presently claimed. With regard to the apparent density and particle size, it is a reasonable assumption that these factors would be the same in the Sakamoto process and the invention, given that the reactants and reaction conditions may be the same in both instances.

Thus, the disclosure of Sakamoto et al. is held to create a prima facie case of obviousness of the presently claimed invention.


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12. In remarks filed with the present RCE, Applicant attempts to distinguish the making of "preoxidized" material as presently claimed from the processes as disclosed in the applied prior art. Applicant's remarks have been carefully considered, but are not persuasive of patentability because this it is unclear how or whether the term "preoxidized" defines any particular distinction in the claimed process (or in its final product) from the processes as disclosed in the applied prior art. The oxidation that occurs in the prior art would result in materials that are oxidized to some extent, and one can designate these materials as "preoxidized" if desired. If Applicant's intent is to require oxidizing of these materials prior to some other event, no such limitation appears in any of the instant claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300. This Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1760

GPW
May 10, 2007